

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 22, 2008. At the time of the Office Action, Claims 1-19 were pending in this Application. Claims 1-8 and 13-19 were rejected. Claims 1, 4, 8, 14, 15, 17, and 19 have been amended to further define various features of Applicants' invention. Claims 9-12 have been withdrawn due to an election/restriction requirement. Claims 7 and 16 have been cancelled without prejudice. Claims 20 and 21 have been added. Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. § 112**

Claims 7 and 19 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicant cancelled Claim 7 without prejudice and amend Claim 19 to overcome these rejections.

#### **Rejections under 35 U.S.C. § 102**

Claims 1-6 and 13-17 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,794,800 issued to Rudolf Heinz ("*Heinz*"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Applicant amended the independent claim 1 to include the limitations of former claim 7 (See arguments presented below with respect to the 35 U.S.C. §103(a) rejection.

With respect to independent claim 14, Applicant amended this claim to include the limitation “*wherein one side of the profiled sheet has first and second contact surfaces spaced at intervals from one another, wherein the profiled sheets are bent such that the first and second contact surfaces press with a predetermined force on the piezoceramic to form an electrical contact, wherein the first and second contact surfaces are formed in such a way that the first contact surfaces form a first contact track and the second contact surfaces form a second contact track.*”

This limitation is disclosed in particular in Fig. 3 and associated description and was also partly included in former claim 16 which has been cancelled without prejudice. *Heinz* does not disclose a profiled sheet with the claimed structure. *Heinz* merely discloses in all embodiment a profiled sheet that has contact surfaces that are arranged on both sides of the profiled sheet to provide for two contact tracks. According to the present invention, however, the contact surfaces 30 and 32 are arranged such that the first contact surfaces 30 form a first contact track 36 whereas the second contact surfaces 32 form a second contact track 34. *Heinz* neither discloses nor suggest such an arrangement.

### **Rejections under 35 U.S.C. §103**

Claims 7 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Heinz* in view of U.S. Patent No. 7,259,504 issued to Willibald Schürz et al. (“*Schürz*”) and U.S. Patent No. 6,316,863 issued to Carsten Schuh et al. (“*Schuh*”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

With respect to former Claim 7 which has been incorporated into independent Claim 1, the Examiner stated that *Schuh* discloses a plastic cage with a cavity into which a piezoceramic is positioned. Applicant agrees that *Schuh* discloses a plastic cage. However, *Schuh* explicitly teaches to provide the plastic cage for reception of a piezoceramic that is already provided with electrodes. See, in particular Fig. 8.

Furthermore, the Examiner stated that *Schürz* also discloses a piezoactuator with a cage material formed around the piezoceramic to which profiled sheets are fixed. Applicant respectfully disagrees. *Schürz* does not disclose a plastic cage. Fig. 2 of *Schürz* shows the electrodes which have a comb like structure. According to *Schürz* these electrodes are directly soldered by means of their ends 12 to a metallization strip 5 on the piezoceramic. See *Schürz* col. 3, lines 37-41. Only the end points 12 of the electrodes are soldered to the strip 5. The rest of the electrode is covered with an adhesive 14 as shown in Fig. 3 and Fig. 4. *Schürz* col. 3, lines 58-60. An adhesive can however not be considered a plastic cage having a cavity. Moreover, the adhesive is applied to the comb like electrode and, therefore, cannot form a cage let alone a cage having a cavity. Moreover, Fig. 5 discloses that once the electrodes have been applied to the piezoceramic, the device can be covered in a continuous layer of adhesive. *Schürz* col. 4, lines 40-53. Again, no cage having a cavity can be formed by applying an adhesive as taught by *Schürz*. Hence, Applicant believes that *Schürz* does not disclose the limitation that the profiled sheets are fixed to an external surface of a plastic cage and the piezoceramic is positioned in a cavity of the plastic cage as claimed in independent claim 1.

Applicants respectfully submit that the remaining dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102 or §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.


**CONCLUSION**

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants

  
Andreas Grubert  
Registration No. 59,143

Date: 5/20/08

SEND CORRESPONDENCE TO:  
BAKER BOTTS L.L.P.  
CUSTOMER ACCOUNT NO. **31625**  
512.322.2545  
512.322.8383 (fax)